



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,379	01/30/2001	Kenzo Tsuji	9448-109US (G0196US)	2582

570 7590 07/25/2005

AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

CHANG, KENT WU

ART UNIT	PAPER NUMBER
----------	--------------

2675

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/774,379	<b>Applicant(s)</b> TSUJI ET AL.	
	<b>Examiner</b> Kent Chang	<b>Art Unit</b> 2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.  
2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 7-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 7-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2675

4. Claims 7 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al (US Patent No.5,629,499) in view of Carini et al (US Patent No. 6,456,740).

Consider claims 7 and 11. Flickinger teaches an electronic-form preparation system comprising:

- a coordinate-input section that emits a signal;
- a coordinate recognition section that receives the signal and recognizes coordinates as a position of the coordinate-input section;
- a form storage section that stores a plurality of items of form data;
- a form selection section that selects one of the plurality of items of form data in accordance with form selection data;
- a data generation selection section that generates an electronic form; and
- a display section on which the electric form is displayed (column 2 line 27 to column 3 line 3, column 3 line 43 to column 4 line 2).

Flickinger is silent in using a character recognition section.

However, Carini teaches to use a data processor including character-recognition unit for recognizing the character handwritten into the form by an input pen on the basis of a coordinates supplied from said coordinate-input device, in which said data processor further includes: identifying-character registration unit for registering identifying characters used for identifying form types, form-format registration unit for registering format for each of said form types; and form-type determining unit for determining a form type of said form by

Art Unit: 2675

comparing an identifying character which has been entered into a predetermined area in said form by said input pen and identified by said character-recognition unit with said identifying characters registered in said identifying-character registration unit; said character-recognition unit reading, from said form-format registration unit, a form-format of an electronic form corresponding to said form whose form type has been determined by said form-type determining unit, and recognizing characters entered into areas other than said predetermined area of said form on the basis of said form-format read from said form-format registration unit; said electronic-form data generating unit generating data of an electronic form corresponding to said form whose form type has been determined by said form-type determining unit (column 4 line 1 to column 5 line 53). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use character-recognition unit as taught by Carini in the device of Flickinger so as to reduce system component cost and makes the identification step a natural part of the form-filling process as suggested by Carini (column 2 lines 1-7).

Furthermore, it would have been obvious for one ordinary skill in the art at the time of the invention to use the character-recognition unit in the device of Flickinger as modified to allow the user to fill the form with a pen since it would further reduce system component cost by eliminating the need of a keyboard and makes the data inputting step a natural part of the form-filling process as suggested by Carini.

Art Unit: 2675

Consider claim 12. Flickinger teaches having a form placed near the coordinate input section (column 4 lines 13-19).

Consider claim 13. Carini teaches a first area for inputting first characters (character inputting for reading the form type).

Consider claim 14. Flickinger teaches connecting the system to a printer for printing the form (column 4 lines 35-39).

Consider claims 15 and 16. The system of Flickinger as modified has a coordinate storage section (179, 187) for storing the coordinate data and a character recognition section.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al (US Patent No.5,629,499) and Carini et al (US Patent No. 6,456,740) as applied to claim 7 above, and further in view of Wood (US Patent 6,414,673).

Consider claims 8-10. Flickinger as modified teaches using a signal emitter and receiver, but is silent in using a signal emitter for emitting signal including an electromagnetic wave and an ultrasonic wave.

However, Wood teaches a coordinate input system having signal emitters for emitting signal including an electromagnetic wave and an ultrasonic wave and multiple receivers (column 15 lines 15-43) so as to enable accurate position detecting and providing supplementary information (column 2 lines 51-62).

Therefore, it would have been obvious for one ordinary skill in the art at the time of the invention to use signal emitters for emitting signal including an electromagnetic wave and an ultrasonic wave as taught by Wood in the device

Art Unit: 2675

of Flickinger as modified so as to enable accurate position detecting and providing supplementary information as suggested by Wood. Moreover, it would have been obvious for one of ordinary skill in the art at the time of the invention to use any well known method such as using hyperbolic curve determining method in calculating the position of the stylus from the input data since any well known method would perform equally well in calculating the position of the stylus.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 7-16 have been considered but are moot in view of the new ground(s) of rejection.

As to applicant's argument that the references of record fails to teach a character recognition section to allow the user to fill the data with a pen, note that Carini teaches to use a data processor including character-recognition unit for recognizing the character handwritten into the form by an input pen on the basis of a coordinates supplied from said coordinate-input device. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use character-recognition unit as taught by Carini in the device of Flickinger so as to reduce system component cost and makes the identification step a natural part of the form-filling process as suggested by Carini (column 2 lines 1-7). Furthermore, it would have been obvious for one ordinary skill in the art at the time of the invention to use the character-recognition unit in the device of Flickinger as modified to allow the user to fill the form with a pen since it would further reduce system component cost by eliminating the need of a

Art Unit: 2675

keyboard and makes the data inputting step a natural part of the form-filling process as suggested by Carini.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### **CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kent Chang whose telephone number is 571-272-7667. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz, can be reached at 571-272-3638.



Art Unit: 2675

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

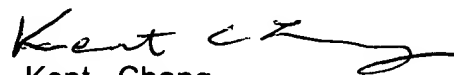
**571-273-8300**

Hand-delivered responses should be brought to the Customer Service

Window, now located at the Randolph Building, 401 Dulany Street,

Alexandria, VA 22314.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kent Chang  
Primary Examiner  
Art Unit 2675

kc

7/16/05